REMARKS

Claims 6-8, 12-14, 16, 18, 19, 22, 23, 30, 31, 34, 35 and 53-84 are all the claims pending

in the application as new claims 80 - 84 are added by this Amendment.

Claim Rejections - 35 U.S.C. § 103(a) - Meade, Helterline and Kelly

The Examiner rejected claims 6-8, 12-14, 16, 18, 19, 22, 23, 30, 31, 34, 35 and 53-79 as

being unpatentable over Meade, II (US 6,405,214; "Meade") in view of Helterline et al. (US

6,039,430; "Helterline") and in further view of Kelly et al. (US 6,645,068). Applicant

respectfully traverses this rejection as follows.

Lack of Motivation to Combine the References

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on

the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) The prior art relied upon,

coupled with the knowledge generally available in the art at the time of the invention, must

contain some suggestion or incentive that would have motivated the artisan motivation. *In re*

Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1984) Further, to be relied upon under 35 U.S.C. § 103 the

reference must be analogous art. To be analogous prior art, the references must: (1) be in the

field of applicant's endeavor; or (2) be reasonably pertinent to the particular problem with which

the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992)

Applicant submits that the Examiner has failed to establish a prima facie case of

obviousness because Kelly is non-analogous art.

First, Applicant's field of endeavor is the field of replacement ink cartridges for printers. (Specification, pg. 1, lines 16-20) In contrast, Kelly is related to a profile driven gaming network and prize redemption system. (see Kelly, Abstract) There is simply no commonality between ink cartridges and gaming systems.

Second, Applicant's particular problem relates to the discarding of ink cartridges after the ink runs empty. (Specification, pg. 3, lines 9-12) More specifically, because the ink cartridge typically comprises a semiconductor memory and a substantial amount of synthetic resin, this discarding results in a considerable waste of resources. (Specification, pg. 1, lines 20-27) Thus, Applicant is providing a solution by providing a user with motivation to participate in cartridge recovery so that resources may be preserved and the environment protected. (Specification, pg. 3, lines 9-13)

In contrast, Kelly is directed to the problem facing a provider of network gaming systems. Particularly, the provider is faced with the problem of managing the types of prizes to be awarded, the number of prizes to be awarded, the amount of each prize, the criteria for awarding prizes and the procedures for redeeming prizes through play on the system. (col. 1, lines 60-67; col. 2 lines 1-3) There is simply no similarity at all between allocating prizes via a gaming system and improving the return rate of consumable ink cartridges. Therefore, Kelly is from a different field of endeavor and is not reasonably pertinent to the particular problem to which the inventor was concerned.

Thus, Applicant submits that claims 6-8, 12-14, 16, 18, 19, 22, 23, 30, 31, 34, 35 and 53-79 are patentable because the Examiner has failed to establish a *prima facie* case of obviousness.

Additionally, even if Meade, Helterline and Kelly are combined as attempted by the

Examiner, the cited combinations fail to teach or suggest all the elements set for in the claims.

Thus, Applicant also traverses these rejections for reasons set forth below.

Claims 6, 57 and 63

The Examiner alleges that Meade teaches many features of claims 6, 57 and 63, but

concedes that Meade fails to teach or suggest:

(1) a replacement cartridge possessing a memory element being installed in the image

forming apparatus; and [Examiner applies Helterline for this feature]

(2) lottery determination data for determining whether something has been won being

stored in the memory element; a reading component for reading the lottery determination data

from the memory element; a lottery determination component that uses lottery determination

data read by the reading component to determine whether something has been won; and a prize

awarding component that performs processing for awarding a prize to a user in correspondence

to the results of a determination carried out by the lottery determination component when the

results of such a determination indicate that something has been won and prize data, being a

prize itself or data from obtaining a prize from a prescribed prize awarding organization, being

stored in the memory element. [Examiner applied Kelly to teach these features]

To compensate for the above noted deficiencies of Meade, the Examiner applies Kelly,

alleging that it teaches a system that reads an identification code from the memory of a

replaceable cartridges and uses said code to allow users to play a game.

However, Applicant respectfully submits that neither Meade, Kelly, Helterline, nor any combination thereof; teaches or suggests: (1) "a replaceable cartridge possessing a memory element being installed in the image forming apparatus, and lottery determination data for determining whether something has been won being stored in the memory element;" and (2) "the prize awarding component records data indicating that something has been won in the memory element of the cartridge."

Specifically, none of the applied references teach "a replacement cartridge possessing a memory element . . . and lottery determination data . . . being stored in the memory element." First, regarding the "replaceable cartridge", the Examiner applies Helterline alleging that it teaches a replaceable cartridge possessing a memory element being installed in the image forming apparatus. However, Helterline fails to teach or suggest the feature, "[L]ottery determination data for determining whether something has been won being stored in the memory element." To provide support for this second feature, the Examiner applies Kelly, alleging that Kelly teaches a system that reads an identification code from the memory of replaceable cartridges and uses said code to allow user's to play a game of chance.

Furthermore, the character of claims 6, 57 and 63 is that the prize awarding component records win data (win data is data indicating that something has been won) to the memory element of the cartridge, and with that, a user wins the prize in exchange for the cartridge (used cartridge). Therefore it will be possible to promote the incentive to put the use cartridge in a certain place (e.g. recycling drop off box), and increase user cooperation in recovery and use of the cartridge and , therefore contribute to prevent a waste of natural resources.

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Kelly describes a removable cartridge 108 that allows the storage of information (i.e. an identification code and an indication of an outcome of the game), the removable cartridge 108 is to be included in dedicated game units 106 and may store information, i.e. identification code and an indication of the outcome of the game. (col. 4, lines 47-50) However, Kelly fails to teach or suggest storing any lottery determination data within the removable cartridge 108. In fact, Kelly describes a system wherein the prize database server 104 tracks the number of prize credits awarded to a user and also functions to allow redemptions of the prize credits for a prize. (col. 4, lines 32-36) Thus, in Kelly, these prize credits are stored in the server, not the removable cartridge 108.

Moreover, Kelly merely describes prize credits earned after playing a game. No portion of Kelly is describes to lottery determination data for determining whether something has been won. The Examiner alleges that Kelly teaches a system that reads an identification code from the memory of the replacement cartridges and uses said code to allow users to play a game of chance. (*citing* Kelly column 4, lines 45-55; column 12, lines 30-55) While this identification code may permit the user to play a game, nowhere does Kelly disclose that this identification number corresponds to lottery determination data as recited in the claims. In contrast, this identification code works like a password to enable a user to play.

Furthermore, there is simply no support in any of the references wherein "a prize awarding component records data indicating that something has been won in the memory element of the cartridge." The Examiner applies Kelly to teach this feature. However, Kelly clearly describes that the prize database server 104 <u>receives</u> an identification code and the

outcome of the present game from game apparatuses 102. Then, the prize database server 104

tracks the number of prize credits awarded to the user. No portion of Kelly teaches that this data

(prize credits) is ever recorded in the removable cartridge 108.

Thus, Applicant submits neither Kelly, Meade nor Helterline, alone or in combination,

teach or suggest all the features of independent claims 6, 57 and 63. Thus, Applicant

respectfully requests that the Examiner withdraw this rejection.

Claims 7, 58, 61, 64 and 67

Claims 7, 58, 61, 64 and 67 recite, *inter alia*, "a replaceable cartridge possessing a

memory element, and lottery determination data for determining whether something has been

won being stored in the memory element." As discussed above, neither Kelly, Meade nor

Helterline, alone or in combination, teach or suggest this feature. Thus, applicant submits that

claims 7, 58, 61, 64 and 67 are allowable over the applied combination.

Claims 8, 30, 62, 65, 66 and 68

Claims 8, 30, 62, 65, 66 and 68 recite, *inter alia*, wherein "prize data, being the prize

itself or data for obtaining the prize from a prescribed prize awarding organization, is stored in

the memory element." As stated earlier, Kelly merely describes that an identification code and

an indication of an outcome of the game are stored in the removable cartridge 108 (col. 4, lines

47-50), wherein the identification code is a user identification code. (col. 4, lines 28-29) Neither

a user identification code nor an indication of the outcome of a game is similar to a prize or data

for obtaining a prize from a prescribed prize awarding organization. For example, a user having

both a user identification number and an indication of the outcome of a game would not have

enough information to obtain a prize from a prescribed prize awarding organization. The user

would have to go elsewhere for this information, thus, this information cannot be said to be

stored in the memory element.

Additionally, each of claims 8, 30, 62, 65, 66 and 68 recite *inter alia*, a replaceable

cartridge possessing a memory element, and lottery determination data for determining whether

something has been won being stored in the memory element. As discussed above, neither

Kelly, Meade nor Helterline, alone or in combination, teach or suggest this feature. Thus,

applicant submits that claims8, 30, 62, 65, 66 and 68 are allowable over the applied combination.

Thus, Applicant submits that claims 8, 30, 62, 65, 66 and 68 are allowable for at least the

above reasons.

Claims 12, 18, 22 and 60

Claims 12, 18, 22 and 60 recite, *inter alia*, a replaceable cartridge possession a memory

element being installed in the image forming apparatus, and prize data, being a prize itself or

data for obtaining a prize from a prescribed prize awarding organization, being stored in the

memory element. This is almost identical to the feature recited in claims 8, 30, 62, 65, 66 and 68

above related to "prize data." Thus, for the same reasons as argued above, Applicants submit

that claims 12, 18, 22 and 60 are allowable over the applied combination.

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Claims 13, 19, 23, 31 and 35

Claims 13 and 19 recite, *inter alia*, "a prize awarding component that performs processing for awarding a prize to a user in correspondence to the usage data read by the reading component." Claim 23 recites, *inter alia*, "a prize awarding component that performs processing for awarding a prize to a user in correspondence to usage data read from the cartridge memory element by the image-forming apparatus." Claim 31 recites, *inter alia*, "a prize awarding step wherein processing for awarding a prize to a user is performed in correspondence to the usage data read at the reading step." Claim 35 recites, *inter alia*, "awarding a prize to a user in correspondence to usage data read from the cartridge memory element."

Regarding this rejection, the Examiner states that it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would use the users' printer usage data or the printer's cartridge identification number to participate in incentive programs such as games of chance and determine if said users have won prizes, as taught by Kelly.

Applicant submits that the applied combination of Meade, Helterline and Kelly fails to teach or suggest, awarding a prize in correspondence to the usage data, as recited in these claims. First, Kelly merely describes only two sources of information on the removable cartridge 108: an identification code and an indication of the outcome of the game. (col. 4, lines 47-50) Furthermore, in contrast to the Examiner's assertion, one of skill in the art would not be motivated to modify Meade to award prizes based on usage. Kelly does not teach awarding any prizes based on usage. To the contrary, Kelly states repeatedly that prize credits are awarded to

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the user based on the outcome of the game. (*See* col. 4, lines 33-34; col. 7, lines 23-25) Thus, there is no support, teaching or motivation within Kelly to modify Meade or Helterline to award a prize based on usage. Finally, the element of basing a prize on a usage data just simply does not exist within any of the applied references.

Thus, Applicant submits the claims 13, 19, 23, 31 and 35 are allowable over the applied combination.

<div style="text-align:center">**Claims 14 and 16**</div>

Claims 14 and 16 recite, *inter alia*, " a component for preventing repeated awarding of prizes" and "a component for performing processing to prevent repeated awarding of prizes on connection with the same cartridge," respectively. Applicant submits that, as discussed above with regard to claims 13, 19, 23 and 31, because awarding a prize to a user in correspondence to usage data read from the cartridge memory is not taught or suggested by the Applied references, that a component for preventing repeated awarding of prizes based on the same usage data is not taught or suggested.

In support of the rejection, the Examiner alleges that Kelly teaches a system that verifies the accuracy of fulfillment of awards. (*citing* Kelly col. 15, lines 1-20) Applicant submits that the Examiner has misread the reference. The portion of Kelly cited does not verify the accuracy of fulfillment awards. In fact, this portion of Kelly describes a system for displaying an ordered list of specific prize credits. For example, the display may incorporate items required by certain business rules, including: a current total number of credits that the player spends per game, the number of prize credits the player has been awarded in the past, a current total of prize credits

available, and a value of a game credit. (col. 15, lines 3-20) This display merely represents prize

credits won or those that are available. This display, as described by Kelly, has nothing to do

with preventing repeated awarding of prizes.

Thus, Applicant submits that claims 14 and 16 are allowable over the applied

combination.

Claims 18, 22, 30 and 34

Claims 18, 22, 30 and 34 recite, *inter alia*, wherein prize data comprises at least one

species selected from among the group consisting of image data serving as a prize itself, image-

forming apparatus driver information serving as a prize itself, a keyword or password which

must be supplied to a prescribed prize awarding organization in order to obtain a prize, and a

URL of a network site which awards a prize." The Examiner seems to allege that Meade

describes these features. (*citing* Meade col. 5, lines 1-20) However, in contrast to the

Examiner's assertion, this portion of Meade merely describes a client program that transmits

transmittable files to a third party server. The transmittable files are gathered from the user

computer and may include printer usage data. But contrary to the Examiner's assertion, this

information does not correspond to the recited image data serving as a prize, driver information

serving as a prize, a keyword or password, or a URL of a network site.

Thus, Applicant submits that claims 18, 22, 30 and 34 are allowable over the applied

combination.

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Claim 79

Regarding claim 79, this claim provides a technique to provide users who put the used cartridge in certain places with a benefit and its technical features is how to identify the user of the cartridge removed from an image forming apparatus. In contrast, Meade and Kelly only provide service for users of an on-line terminal and, thus, they do not describe a technique how to identify the user of the removed cartridge.

Claim Rejections - 35 U.S.C. § 103(a) - Meade and Hayward

The Examiner rejected claims 69-72 and 75-78 as being unpatentable over Meade in view of Hayward (US 6,629,134).

The Examiner alleges that Meade teaches many of the features of claims 69, 71 and 75-78, but concedes that Meade fails to teach or suggest updating software which requires to be updated to the software for control which has been received from the information providing server. (Office Action, page 6) To compensate for Meade's deficiencies, the Examiner applies Hayward alleging that it teaches a system that detects a computer's peripheral conditions and provides user support based upon said detection. (*citing* col. 6, lines 20-57).

Regarding claim 69, in contrast to the Examiner's contentions, Applicant submits that neither Meade nor Hayward, alone or in combination, teach or suggest "transmitting software for control, which is used when the client performs printing using the cartridge," as recited in claim 69

Meade is silent on downloading any software for control as it is primarily directed to installing cookies to collect and transmit information from the computer. Hayward, on the other hand, is directed to downloading user support information. However, the user support information described in Hayward is not related to control software, which is used when the client performs printing using the cartridge. Basically, Hayward describes a system that detects a peripheral condition of a device, and then provides user support based on the condition sensed. (col. 6, lines 25-30) This "user support information" is described as help information. When the product is launched, the manufacturer prepares "user support information" to ship with the product, which may later be installed with the installation software to be later accessed from a help menu. (col. 4, lines 19-22) Thus, Hayward it geared toward using specific peripheral indicia to identify specific user support that may need updating, or alternatively removing outdated support information. (col. 4, lines 55-60)

Therefore, the user support information as described by Hayward is merely help and diagnostic information, not control software. Hayward is silent on downloading software for control, as recited. Thus, Applicant respectfully submits that claim 69 is allowable over the applied combination. Furthermore, Applicant submits that claim 70 is allowable, at least because of

Regarding claim 71, Applicant submit that neither Hayward nor Meade teach or suggest "transmitting printing data, which is to be supplied to the image-forming apparatus" and "processing the printing data received ... to perform printing." No portion of Hayward or Meade describes a system where printing data is transmitted and printed. Both Hayward and Meade are

limited to the uploading and downloading of information that is stored on the computer or server. Furthermore, neither reference indicates that printing is performed as a part of the upload/download process. Because neither reference discloses or describes transmitting printing data and processing the same, Applicant submits that claim 71 is allowable over the applied combination. Furthermore, Applicant submits that claim 72 is allowable, at least because of its dependency.

Furthermore, claims 69 and 71 recite, *inter alia*, "acquiring a first resource information in connection with a resource of the client" and "of the image forming apparatus." However, none of the cited references describe that sending the software for a control based on the information regarding both the image-forming apparatus and the client resources. Meade describes providing the information based on a cookie, but it does not describe writing the resources of both the client and the image-forming apparatus. Because claims 75 and 77 recite similar features, Applicant submits they are allowable for this reason as well.

Regarding claim 75 and 78, because these claims recite the "software for control" as recited in claim 69, Applicant submits that these claims are allowable for the same reasons argued above.

Regarding claims 76 and 77, because the recitation "an information-providing server to transmit printing data" and " an image forming apparatus configured to process the print data received," are similar to the recitations argued with regard to claim 71 above, Applicant submits that these claims are allowable for the same reasons.

Claim Rejections - 35 U.S.C. § 103(a) - Meade, Helterline and Hayward

The Examiner rejected claim s 53-56, 73 and 74 as being unpatentable over Meade in view of Helterline and in further view of Hayward. Applicant respectfully traverses this rejection as follows.

The Examiner alleges that Meade teaches most of the elements of the foregoing claims, but concedes that Meade fails to teach or suggest wherein the cartridge is provided with a memory element and a URL and password for the information-providing server is stored in the memory element. (Office Action, page 10) To compensate for this deficiency the Examiner applies Helterline and Hayward. First, the Examiner contends that Helterline teaches a replaceable cartridge with a memory element. Second, the Examiner states that Hayward teaches a system that detects a users' computer peripheral conditions and provides to the users support information based on the detection. (*citin* Hayward, col. 6, lines 20-57) Then the Examiner concludes by stating it would have been obvious to one of ordinary skill in the art to know that Helterline and Meade would transmit to a remote server users' computer peripheral conditions for the purpose of transmitting to the users support information and target promotions.

However, Applicant submits that the applied combination of Meade, Helterline and Hayward fail to teach or suggest, wherein "a URL for the server and a password for permitting access to the server are stored in the memory element of the cartridge," as recited in claim 53. Moreover, the Examiner has failed to even allege that these features are taught by a reference within this rejection. In any event, none of the references describe a URL and a password that is stored in the memory element of the replaceable cartridge.

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First, Helterline consistently describes things such as actual ink drops emitted from the

printhead, a date code associated with the ink container, date code of initial insertion of the ink

container, ink color/type, age of the ink; printer model number, etc.; as being stored in the

removable cartridge. These are all items directly related to the ink cartridge, the printer or

printing. There is no indication of using the removable cartridge for storing any other type of

information.

Second, Hayward describes an external communications browser which accesses a

manufacturer's server at an address defined by the peripheral condition. Hayward describes that

the address might be "www.manufacture.com/product/xxx," where the product is the peripheral

indicia. (col. 6, lines 29-45) As taught by Hayward, there is no URL stored in a peripheral

device. To the contrary, the peripheral indicia is detected from the peripheral device and then the

external browser creates the server's address by constructing it from the peripheral indicia as

shown above. In this case, the server's address must include the product name. In contrast to

this method, claim 53 recites a URL for the server and a password for permitting access to the

server are stored in the memory element of the cartridge. No subsequent programming is

required to recreate the address, it already exists. Furthermore, none of the references mention

using a password with respect to the removable cartridge. Thus, the applied combination of

Meade, Helterline and Hayward fail to teach or suggest this feature.

Third, claim 53 may be characterized in that it accesses the Webpage to provide the

sample printing image data corresponding to the ink cartridge ID. With this, it can provide the

image data corresponding to the quality of ink in the particular cartridge and, then, print the

image data according to the ink quality. In contrast, Hayward describes that access to the

Webpage is based on a peripheral condition which contains the code indicating the consumable.

The peripheral condition is different from a cartridge ID, and it cannot be replaced. It is, for

example, clear that the peripheral and consumable are taken aside in the Abstract in Hayward.

Therefore, Applicant respectfully submits that claim 53 is allowable over the applied

combination.

Regarding claims 55 and 73, Applicant submits that these claims are allowable for similar

reasons to claim 53 as they recite reading the URL address and the password from the memory

of the removable cartridge. Furthermore, claim 74 is allowable, at least because of its

dependency from claim 73.

New Claims

New claims 80 - 84 have been added. Claims 83 and 84 are supported, at least, by FIGS.

16-21 and pages 39-48 of the original specification. This portion of the specification is

generally directed to a system configuration and the corresponding provisions of control software

(and updating), online sample printing data and user support information.
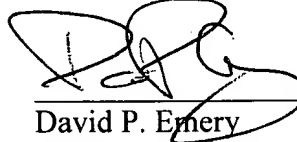

Conclusion

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

David P. Emery
Registration No. 55,154

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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